

REMARKS

This responds to the Office Action mailed on October 5, 2005.

Claims 9, 17, 20, and 29 are amended. No claims are canceled or added. As a result, claims 1-30 remain pending in this application.

For the convenience of the Examiner, Applicant's remarks concerning the claims will be presented in the same order in which the Examiner presented them in the Office Action.

Request for Form 892

Applicant notes that the Examiner referenced Hezeltine (U.S. 6,622,802) in rejections of the claims of the present application. However, there was no Form 892 listing Hezeltine (U.S. 6,622,802) supplied to Applicant with the recent Office Action. Accordingly, Applicant requests that the Examiner provide a Form 892 listing Hezeltine with the next communication to the Applicant.

Information Disclosure Statement Previously Submitted on February 22, 2005

Applicant filed an Information Disclosure Statement on February 22, 2005. To date, Applicant has not received the Form 1449 filed therewith and marked as being considered by the Examiner. Pursuant to the provisions of MPEP 609, Applicant requests that a copy of the Form 1449, with each citation initialed as being considered by the Examiner, be returned to the Applicant with the next official communication.

Amendments to Claims 9, 17, 20, and 29

Claims 9, 17, 20, and 29 have been amended. No new matter has been introduced.

In claims 9, 20, and 29, the phrase "to couple to a vacuum generator, wherein the vacuum element is" has been added.

In claim 17, the phrase "to couple to a vacuum generator" has been added.

Support for the additional language may be found, for example, in original claim 6.

Rejection of Claims 9, 17, 20, and 29
under 35 U.S.C. §101 “Same Invention”
Type Double Patenting

Claims 9, 20, and 29 were rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1, 11 and 21, respectively, of U.S. Patent No. 6,622,802.

Claims 17 was rejected under 35 U.S.C. §101 as claiming the same invention as that of claim 16 of U.S. Patent No. 6,622,802.

A “same invention” type double patenting rejection can be overcome by amending the conflicting claims so they are no longer coextensive in scope.

Claims 9, 17, 20, and 29 have been amended, as mentioned above.

Accordingly, Applicant respectfully requests that the rejection of claims 9, 17, 20, and 29 under 35 U.S.C. §101 “same invention” type double patenting be withdrawn.

Rejection of Claims 1-8, 10-12, 18-19, 21-28, and 30
Under the Judicially-Created Doctrine
of Obviousness-Type Double Patenting
over Claims of U.S. Patent No. 6,622,802

Claims 1-8, 10, and 11 were rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, respectively, of U.S. Patent No. 6,622,802.

Claims 12-16, 18, 19, 21, and 22 were rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 11-15 and 17-20, respectively, of U.S. Patent No. 6,622,802.

Claims 23-28 and 30 were rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 21-27, respectively, of U.S. Patent No. 6,622,802.

The Examiner states that the conflicting claims are not patentably distinct from each other, and that the claims of the present application omit the feature non-critical to patentability, for example, a vacuum element.

Applicant respectfully asserts that claims 1-8, 10-12, 18-19, 21-28, and 30 of the present application are patentably distinct from those of Applicant's own U.S. Patent No. 6,622,802. Applicant points out that the claims of U.S. Patent No. 6,622,802 were allowed when each independent claim 1, 11, and 33 was amended to recite a "vacuum element". Applicant can only surmise that the "vacuum element" played a significant, if not essential, role in contributing to the patentability of independent claims 1, 11, and 33 of Applicant's parent application.

For the above reasons, Applicant respectfully requests that the rejection of claims 1-8, 10-12, 18-19, 21-28, and 30 under the judicially-created doctrine of obviousness-type double patenting be withdrawn.

However, should the Examiner continue to maintain this ground of rejection, Applicant would consider filing a suitable terminal disclaimer in compliance with 37 CFR 1.321 at an appropriate time.

Rejection of Claims 1-30 Under 35 U.S.C. §102(e)
as Anticipated by Hezeltine

Claims 1-30 were rejected under 35 U.S.C. §102(e) as being anticipated by Hezeltine (U.S. 6,622,802).

As stated in its opening paragraph, the present application is a continuation of Serial No. 09/821,247, which issued as U.S. Patent No. 6,622,802. The present application was filed before U.S. Patent No. 6,622,802 issued.

U.S. Patent No. 6,622,802 is not a proper reference under 35 U.S.C. §102(e), because it does not disclose the inventive subject matter of "another". It discloses Applicant's own inventive subject matter.

For the above reason, Applicant respectfully requests that the rejection of claims 1-30 under 35 U.S.C. §102(e) as being anticipated by Hezeltine be withdrawn, and that U.S. Patent No. 6,622,802 be withdrawn as a reference in the present application.

Rejection of Claims 1-5, 12-16, 21, and 23-25
Under 35 U.S.C. §103(a)
As Being Unpatentable over Tanaka in View of Maier

Claims 1-5, 12-16, 21, and 23-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tanaka (U.S. 5,437,339) in view of Maier et al. (U.S. 4,213,301).

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

Tanaka appears to disclose an air-pressure-operated nail gun having a cylinder 1 (FIG. 1) and a sub-cylinder 6. A piston 2 is movable within cylinder 1. Piston 2 has a physically integral driver 3 that is movable within nose assembly 4 to drive a nail. A weight piston 7 is movable within sub-cylinder 6. Weight piston 7 is in contact with a compression spring 8. When air is introduced into cylinder 1 and sub-cylinder 6 via an air supply inlet 9, piston 2 moves downward, and weight piston 7 moves upward. The upward reactive force generated by piston 2 moving downward is described as being offset by a downward force F2 on the shoulder 1' of sub-cylinder 6, causing the nail gun housing to be pushed against the work piece into which the nail is being driven (see column 5, line 46 through column 6, line 5).

Maier appears to disclose an apparatus for driving fastening elements (see Abstract). The apparatus includes a double-headed piston 13 (FIG. 2, described in col. 5, lines 51-58) and a drive piston 5 (see col. 5, line 8) having a shaft 5b to contact a fastening element 15 (FIG. 3).

No disclosure could be found in Tanaka or Maier, whether considered individually or in combination, of all of the claim limitations present in independent claims 1, 12, and 23.

For example, regarding independent claims 1 and 12, no disclosure could be found in either Tanaka or Maier of a propulsion element (claim 1) or an air delivery infrastructure (claim 12) to propel the piston against the pin [emphasis added]. In Applicant's subject matter, the piston physically strikes the pin. Applicant could not find this disclosed in either reference.

Regarding independent claim 23, no disclosure could be found in either Tanaka or Maier of an air delivery infrastructure to propel the primary hammer against a secondary hammer [emphasis added]. In Applicant's subject matter, the primary hammer physically strikes the secondary hammer. Applicant could not find this disclosed in either reference.

The asserted combination of Tanaka in view of Maier fails to teach or suggest all of the claim limitations present in independent claims 1, 12, and 23, so a *prima facie* case of obviousness has not been established.

The Examiner, in setting forth his grounds for this rejection and in making his “Response to Arguments”, is not considering the entirety of the phrase “a propulsion element coupled to the body to propel the piston against the pin” [emphasis added]. The Examiner argues that Tanaka discloses a “propulsion element” (claim 1) or “air delivery infrastructure” (claims 12 and 23). However, the Examiner completely ignores the language “to propel the piston against the pin” (claims 1 and 12) and “to propel the primary hammer against the secondary hammer” (claim 23).

Further, regarding Tanaka, the Examiner’s characterization of weight piston 7 (col. 5, line 23) as a “primary hammer” is incorrect and erroneous. Weight piston 7 is in no sense a “hammer”, because it doesn’t strike or even touch impulsion piston 2 (col. 5, line 10). Weight piston 7 actually moves upward in the sub-cylinder 6 (col. 5, lines 43-45), not downwardly to strike or touch impulsion piston 2.

Regarding Maier, the Examiner incorrectly states that “Maier discloses an air delivery infrastructure . . . which propels the primary hammer (13c) against the secondary hammer (5). Maier describes his element 13c as a double-headed piston (col. 5, line 51), and Maier further describes his element 5 as a drive piston (col. 5, line 8). It is clear from FIGS. 2-4 of Maier, and from the accompanying description of FIGS. 2-4, that double-headed piston 13c does not function as a “hammer” in any sense of the word, because it doesn’t strike or even touch drive piston 5.

For these reasons, independent claims 1, 12, and 23 should be found to be allowable over Tanaka and Maier, and Applicant respectfully requests that the rejection of claims 1, 12, and 23 under 35 U.S.C. §103(a) as unpatentable over Tanaka in view of Maier be withdrawn.

Claims 2-5, 13-16, 21, and 24-25, which depend directly or indirectly from independent claims 1, 11, and 33, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Rejection of Claims 11, 22, and 30
Under 35 U.S.C. §103(a) As Being Unpatentable
over Tanaka in View of Maier and Further in View of Lindsay

Claims 11, 22, and 30 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Tanaka in view of Maier et al. and further in view of Lindsay (U.S. 6,095,256).

Tanaka and Maier were discussed above.

Lindsay appears to disclose a hand-held pneumatic impact/engraving tool having a foot-operated control valve 88 (FIG. 17). The control valve 88 includes a barbed connector 114 to which a delivery line 38 to the tool 26 (FIG. 1) is coupled, and the control valve 88 further includes a barbed connector 116 to which a distribution line 32 (FIG. 1) from a pressure regulator assembly 20 may be connected.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

The asserted combination of Tanaka in view of Maier and Lindsay fails to teach or suggest all of the claim limitations present in independent claims 1, 12, and 23, so a *prima facie* case of obviousness has not been established.

Regarding independent claim 1, no disclosure could be found in these three references of a propulsion element coupled to the body to propel the piston against the pin [emphasis added].

Further regarding independent claim 12, no disclosure could be found in these three references of an air delivery infrastructure to propel the piston against the pin [emphasis added].

Regarding independent claim 23, no disclosure could be found in these three references of an air delivery infrastructure to propel the primary hammer against a secondary hammer [emphasis added].

For these reasons, independent claims 1, 12, and 23 should be found to be allowable over Tanaka in view of Maier and Lindsay.

Claims 11, 22, and 30, which depend from independent claims 1, 12, and 23, respectively, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Applicant respectfully requests that the rejection of claims 11, 22, and 30 under 35 U.S.C. §103(a) as unpatentable over Tanaka in view of Maier and Lindsay be withdrawn.

Conclusion

Applicant respectfully submits that claims 1-30 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602) 298-8920, or the below-signed attorney (located in Minneapolis, Minnesota) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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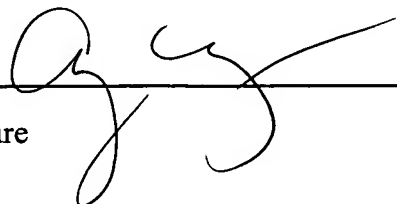
Date Jan. 5, 2006

By Ann M. McCrackin
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 5th day of January, 2006.

Amy Moriarty

Name


Signature